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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,261	03/23/2004	Daniel W. Rodlin	03-113	4184

27219 7590 03/16/2010
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EXAMINER

CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

NOTIFICATION DATE	DELIVERY MODE
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03/16/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

COHENLAW@COHENIPLAW.COM

Office Action Summary	Application No. 10/808,261	Applicant(s) RODLIN, DANIEL W.	
	Examiner ROBERT J. CANFIELD	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-42, 45, 46 and 48-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43, 44 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This Office action is a first action on the merits for application serial number 10/808,261 filed 03/23/04. Claims 1-60 are pending.

2. Applicant's election with traverse of Group II, method claims 43-60, and the species of Figure 21, claims 43, 44, and 47 in the reply filed on 10/07/09 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement between Group I and Group II, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The traversal of the Species restriction is on the ground(s) that:

- a. The conclusion that the figures show structurally different embodiment is not a sufficient basis for requiring different specie,
- b. There are generic claims,
- c. The commonality. Of each relief form is apparent, and
- d. There is no serious searching burden on the examiner.

This is not found persuasive because where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct. It is the different structural features of the different embodiments which render the species distinct. While searching the examiner would have to search for all of the different embodiments. This may require additional subclasses not required for one embodiment and/or different

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text queries for the different features of the different embodiments. Further, the different structural features of the different embodiments could require writing multiple art rejections and responding to multiple arguments. All of which places an undue burden on the examiner. Applicant is reminded that should a generic claim be found allowable applicant is entitled to rejoin depended claims directed to non-elected species.

The requirement is still deemed proper and is therefore made **FINAL**. Claims 1-42, 45, 46 and 48-60 are withdrawn from consideration for being directed to non-elected inventions/embodiments.

3. The disclosure is objected to because of the following informalities: the first sentence of the specification recites that the application is a CIP of application serial number 10/679,720 which is a DIV of application serial number 10/679,720. It is unclear how application serial number 10/679,720 can be a DIV of itself. Further, the specification should be amended to reflect that application serial number 10/808/261 is now abandoned.

Appropriate correction is required.

4. The title of the invention is not descriptive. The title fails to reflect that a method of making is claimed. A new title is required that is clearly indicative of the invention to which the claims are directed.

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5. It appears that *at least* Figures 17a, 19 and 20 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). As understood these are the “commercially available corner aids”. Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 43, 44 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language “commercially available corner aids” renders the claims indefinite as what is commercially available may change with time and location.

In claim 47 “the fixture” lacks antecedent basis.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,005,572 to Vass.

In Figure 5 Vass teaches that at the time of the invention it was known to position lengthwise and fasten two corner beads together via intermediate expanded metal (30) to form a relief form.

10. Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2465,756 to Schepis.

Clip (1) fastens together two corner aids (C) along their length.

11. Claims 43, 44 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,665,666 to Hampton.

Hampton provides positioning a first (6) and a second (10) corner aid lengthwise oppositely each other and securing the pair of corner aid sections with a suitable adhesive. Hampton further provides initially lining the mold with paper (24) which is bonded to the length of the relief form.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. CANFIELD whose telephone number is (571)272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rich Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert J Canfield
Primary Examiner
Art Unit 3635

/Robert J Canfield/

Primary Examiner, Art Unit 3635